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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,116	02/25/2000	Eric Mao		6642

7590 08/12/2003

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EXAMINER
SHIPSIDES, GEOFFREY P

ART UNIT	PAPER NUMBER
1732	

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No. 09/513,116	Applicant(s) MAO, ERIC
	Examiner Geoffrey P. Shipsides	Art Unit 1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 7 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 7 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in the original specification on page 1 (Admission) in view of U.S. Patent No. 4,163,819 (Yung et al.) and U.S. Patent No. 5,964,009 (Hoepfl et al.).

Admission teaches that it is known to provide a soft ribbon stripe with a plastic mark (Page 1, lines 13-14 of the original specification). Admission teaches it is conventionally known to place a rigid article within a recess of a mold followed by injecting material into the mold to provide the surface of the molded article with a specific mark or logo (Page 1, lines 9-12 of the original specification).

With regard to claim 6, Admission does not teach the thermal pressing of a combination end of the ribbon stripe to cure a texture of the ribbon stripe. Yung et al. teaches that heat and pressure will cause a non-woven fabric to become stiff (Column 2, lines 7-26). It would have been obvious to one having ordinary skill in the art at the time of invention to use heat and pressure (thermally press) the part of the soft ribbon stripe (as taught by Admission) in order to make the ribbon strip stiff (or rigid) as taught by Yung et al. in order to make the soft ribbon stripe suitable for conventional injection molding process for forming a specific mark or logo on to the soft ribbon stripe.

Admission, further, does not teach a two part molding operation where a first material forms an inner part with only a protruding trademark exposed in the final product, and a second material that is injection molded over the first material. Hoepfl et al. teaches such a process for forming tool handles (figures, Column 2, lines 47-65). It would have been obvious to one having ordinary skill in the art at the time of invention to use the process of Hoepfl of forming a decorative injection molded part on to the ribbon stripe as taught by Admission in order to form a more resilient decoration (trademark).

Admission does not teach a process of mixing injection molding material with material similar or alike the material of the ribbon stripe. It is, however, notoriously well known in the art of injection molding to use compatible materials in composite injection molding process in order to form a stronger bond between the preform and the injection molded material. It would have been obvious to one having ordinary skill in the art at the time of invention to mix compatible (similar) material into the first injection molded material in order to form a better bond between the ribbon stripe and the injection molded material as is well known in the art.

Response to Arguments

3. Applicant's arguments filed 7-14-03 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant further seems to claim that the admission does not admit that the process of molding on a ribbon stripe is known (which is clearly admitted on page 1, lines 13-15 of the original specification).

The applicant seems to imply that there is no suggestion to combine the references. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one looking to solve the known problems with putting a trademark design on the end of a ribbon stripe would have clearly seen that these problems are not associated with the admittedly known process of injection molding onto the end of a stiff preform. It would have been obvious to one having ordinary skill in the art at the time of invention to then look for means to stiffen a ribbon stripe and in view of Yung et al. one having ordinary skill in the art would have found it obvious to use heat and pressure to stiffen the non-woven fabric of a ribbon stripe. Further, it would have been obvious to one having ordinary skill in the art at the time of invention when looking to make a decorative molding onto the end of an object to look at the different decorative molding techniques such as Hoepfl et al. and it would have been obvious to one having ordinary skill in the art at the time of

invention to make the trademark on the end of the ribbon stripe as taught by Admission by the decorative molding technique of Hoepfl et al. in order to produce a resilient decorative appearance. The examiner holds this to be a prima facie case of obviousness against the instantly claimed process.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey P. Shipsides whose telephone number is 703-306-0311. The examiner can normally be reached on Monday - Friday 9 AM till 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 703-305-5493. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

GPS
Geoffrey P. Shipsides/gps
August 10, 2003

MARK EASHOO, PH.D
PRIMARY EXAMINER
Art Unit 1732
11/Aug/03